

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH S. LOHMANN

Appeal No. 2001-0205
Application No. 08/692,016

ON BRIEF

Before Senior Administrative Patent Judge McCANDLISH, ABRAMS, and BAHR,
Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4-10 and 13-17. Claims 3, 11 and 12 have been withdrawn from consideration as being directed to a non-elected invention.

We REVERSE AND ENTER NEW REJECTIONS UNDER 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a device for holding open and facilitating the filling of a trash bag. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Berger	1,554,550	Sep. 22, 1925
Flagg	4,040,638	Aug. 9, 1977
Beckham	4,832,292	May 23, 1989
Tobin	5,129,609	Jul. 14, 1992

The following rejections stand under 35 U.S.C. § 103:

- (1) Claims 1, 2, 4, 5, 9 and 13-16 on the basis of Tobin and Flagg.
- (2) Claims 6, 7 and 17 on the basis of Tobin, Flagg and Beckham.
- (3) Claims 8 and 10 on the basis of Tobin, Flagg and Berger.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 23) for the examiner's complete reasoning in support of the rejections, and to the Supplemental Brief (Paper No. 22) for the appellant's arguments thereagainst.

¹Flagg was omitted from the statement of this rejection in the final rejection and in the Answer. However, inasmuch as both of these claims depend from claim 1, against which Flagg was applied, we consider this omission to have been inadvertent.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention comprises a trash bag having at least one knot in the edge thereof and a hollow frame for holding the bag open and facilitating filling it with debris. The frame has sidewalls having at least one hole therethrough, with each of the holes having a longitudinal slit extending from the hole. The knots in the bag are passed through the holes and the bag is secured in the slits.

The Examiner's Standing Rejections

As explained below, we find serious problems in the claims with regard to 35 U.S.C. § 112, first and second paragraphs, and we have entered new rejections in this regard. However, there are ample reasons to reverse the examiner's rejections on the basis of the applied prior art without considering those portions of the claims with which we take issue under Section 112, and in the interest of judicial economy we shall dispose of these matters.

The first of the examiner's rejections is that claims 1, 2, 4, 5, 9 and 13-16 would have been obvious in view of the combined teachings of Tobin and Flagg.²

Independent claim 1 is directed to a device for holding open and facilitating the filling of a trash bag. Among the structure recited is a frame having opposite sidewalls, each of which provided with a hole having a longitudinal slit extending therefrom. Also recited is a trash bag having an open mouth and comprising at least two knots tied in the peripheral edge of the open mouth, the size of the holes being such that the knots can pass through, and the knots "being drawn through said holes within said opposite sidewalls of said frame and securely but detachably retained in said corresponding slits of said holes."

Tobin discloses a frame for holding a trash bag open. The frame includes opposite sidewalls with each having a hole with a slit extending therefrom. Flagg discloses a refuse

² The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

conveying vehicle in which a frame holds a trash bag open by engaging knots tied in the peripheral edge of the bag with slots in the frame (see Figure 2). It is the examiner's position that it would have been obvious to one of ordinary skill in the art to tie knots in the peripheral edge of the Tobin trash bag in view of the teaching of Flagg, to provide a more secure attachment of the bag to the frame. We do not agree with the examiner's conclusion on the basis that no suggestion exists to combine Tobin and Flagg in the manner proposed. In the Tobin arrangement the bag is held upright and is not suspended from the frame, and the frame is provided with additional slots 26 to accommodate taller bags. Tobin teaches that "a part of the plastic bag 16 may be drawn through the body of the teardrop [hole] and then pulled downwards, thus frictionally securing the bag into the plastic bag holding slot 24" (column 4, lines 59-63). Therefore, it is sufficient for Tobin to hold the edge of the bag frictionally in the slit, from which we conclude that the artisan would not have been motivated to add the knot for lack of any perceived necessity to do so, that is, there is no evidence that such would be an improvement or would otherwise solve a problem with the Tobin system. It should further be noted that, unlike Tobin, Flagg utilizes a slot rather than a slit and requires the presence of a knot to insure that the periphery of the bag is retained in the slot, which is unnecessary in the Tobin arrangement, where it is clamped within a slit. Moreover, even if suggestion to combine were found to be present, the resulting combination would not yield the invention recited in the claim, for

there is no teaching of securely but detachably retaining the knots “within” the slits which extend from the holes, which is the structure recited in claim 1.

It therefore is our opinion that the teachings of Tobin and Flagg fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we will not sustain this rejection. It follows that the rejection of claims 2, 4, 5 and 9, which depend from claim 1, also will not be sustained.

Independent claims 13 and 16 also stand rejected on the basis of Tobin and Flagg. Claim 13 contains the same limitations regarding providing the knots and retaining the knots in the slits of the holes, and the rejection of independent claim 13 and dependent claims 14 and 15 is not sustained for the same reasons as were set forth above with regard to claim 1.

Claim 16 requires the knots, and goes on to state that “said knot is drawn through said hole within walls of said frame and securely but detachable retained therein.” Again, there is no suggestion for adding the knots to the Tobin bag, and the rejection of claim 16 fails on that basis. In addition, while claim 16 does not require the slits, it does require that the knots be “securely” retained. The examiner has not explained, and we cannot appreciate, how the knots in the Flagg device can be considered to be “securely” retained, inasmuch as they appear to be freely removable through the open top of the slot. The rejection of claim 16 is not sustained.

Claim 17 stands rejected on the basis of Tobin and Flagg, taken further with Beckham. Claim 17 is directed to a method of retaining a trash bag, and it defines the structure recited in claim 1 regarding the knots and the securing of the knots within the slits. The combined teachings of Tobin and Flagg fail to render this claim obvious for the reasons expressed above with claims 1, 13, and 16. Beckham, which was cited for teaching making frames of plastic, was cited against this claim because of the requirement that the frame be “unitarily molded.” Be that as it may, Beckham fails to alleviate the shortcomings in the other two references, and therefore the rejection of claim 17 cannot be sustained.³ We reach the same conclusion with regard to claims 6 and 7, which depend from claim 1 and also are rejected on Tobin, Flagg and Beckham.

Finally, claims 8 and 9, which depend from claim 1, stand rejected on the basis of Tobin, Flagg and Berger, the latter being cited for teaching using metal for a frame. As was the case with Beckham, Berger fails to cure the defect with the other two references, and the rejection is not sustained.

New Rejections By The Board

³ What appears clearly to be an inadvertent error appears in claim 17, in that the first step of claim 17 recites “knotting at least two areas of a peripheral edge of a trash bag,” whereas the final step of the claim refers to “said knotted portions” (emphasis added). This is worthy of correction.

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new rejections:

(1)

Claims 1, 2, 4-10 and 16 are rejected under 35 U.S.C. § 112, first paragraph, as failing to describe the invention in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.

The trash bag recited in independent claims 1 and 16 comprises at least two knots, with each of said knots “having a diameter so as to substantially support the weight of said debris when said trash bag is full.” This relationship between the diameter of the knot and the weight of the debris in the bag is not explicitly described in the specification and, in our view, is not apparent from the original disclosure. In addition, from our perspective, how to achieve this claimed relationship without undue experimentation would not have been apparent to one of ordinary skill in the art from the information provided in the original disclosure. This being the case, the above-quoted limitation is neither described⁴ nor

⁴The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

(continued...)

enabled⁵ in the manner required by the first paragraph of Section 112, and thus independent claims 1 and 16 and dependent claims 2 and 4-10 are not in compliance therewith.

Additionally, claim 16 states that the knot “is drawn through said hole within walls of said frame and securely but detachably retained therein” (emphasis added). The initial question that arises here is whether “therein” refers to the “hole” or to “within walls of said frame,” that is, whether the knot is retained in the hole or is retained within the walls of the frame. While the specification states that the knots are “directed” or “pulled” into the slits (page 7, line 16; page 12, lines 9 and 10), there is no description in the specification that the knots are retained in the holes nor, in our view, is such an arrangement apparent therefrom. While not clearly shown, Figures 4, 8 and 9 of the drawings could be interpreted as showing the knots on the inside of the frame, but no description of such

⁴(...continued)

⁵An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989).

appears in the specification. It is not apparent how one of ordinary skill in the art could, without undue experimentation, “securely but detachably” retain the knots in the holes, nor is there a description in the specification of “securely but detachably” retaining the knots “within walls of said frame,” and it is not apparent how one of ordinary skill in the art would accomplish this without undue experimentation. In any event, it is our view that this portion of claim 16 is not supported in the original disclosure, and therefore fails to meet both the description and the enablement requirements of section 112, first paragraph.

(2)

Claims 1, 2, 4-10 and 13-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

The preambles of independent apparatus claims 1 and 13 each state that the invention is “[a] device for holding open and facilitating the filling of a trash bag” (emphasis added). This would indicate that the claim is directed to the device and not to the combination of the device and the bag it is intended to hold open. However, after setting forth the structure of the device in the first paragraph of the body, the claims go on to describe the trash bag and to relate the structure of the trash bag to the frame, which would suggest that the claim is drawn to the combination of the frame and the bag. The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area

with a reasonable degree of precision and particularity.⁶ It is our opinion that the inconsistency noted above would cause one of ordinary skill in the art not to be able to determine the metes and bounds of the claims, and therefore claims 1, 2, 4-10 and 13-15 must be considered to be indefinite on this basis.

We reach the same conclusion, for the same reason, with regard to independent apparatus claim 16. In this case the preamble of the claim states that the invention is directed to “[a] trash bag for use with a hollow frame” (emphasis added). However, the body of the claim not only positively recites the structure of the bag, but also positively recites the frame, stating that the knot is “engaged with the frame,” the bag is “received upon said rear exit end of said frame and fitted over a majority of said frame” and “extends beyond said hollow frame,” the “holes [in the frame] each having a size corresponding with said knot,” and the knot “is drawn through said hole within walls of said frame and securely but detachably retained therein.” The issue again arises as to whether the claim is directed to a single element or to a combination of two elements, which renders the claim indefinite.

The phrase “said knots having a diameter so as to substantially support the weight of said debris when said trash bag is full” also causes independent claims 1 and 16 and dependent claims 2 and 4-10 to be indefinite, for two reasons. First, as we stated above,

⁶ In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

this relationship is not explained in the specification and is not apparent therefrom. In the absence of explanation, it is not clear how the diameter of the knot as compared to the weight of the debris is a factor in supporting the bag on the frame and, equally importantly, how one would determine whether a knot having a particular diameter falls within the scope of the claims. A second, and related basis, is that “substantially” is used to define the degree to which the weight of the debris need be supported in order to fall within the scope of the claims. However, no guidance has been provided in the specification as to what values or range of values comprise the required amount of support, and therefore one of ordinary skill in the art would be unable to determine what constitutes “substantial” support of the weight of the debris, as opposed to what is not substantial. Thus, considering the two instances referred to above in and of themselves as well as in light of the specification, it is our view that this phraseology does not allow one of ordinary skill in the art to readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance, which is required by the second paragraph of Section 112.⁷

⁷See Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984)(when a word of degree is used, such as the term “substantially,” it is necessary to determine whether the specification provides some standard for measuring that degree.), and In re Hammack, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970).

Additionally, it is not clear from the recitation in the final two lines of claim 16 whether the knots are "securely but detachably" retained in the hole or within the walls of the frame. As we explained above, the specification provides no answer to this question. The claim therefore is indefinite on this basis.

SUMMARY

The examiner's rejection of claims 1, 2, 4, 5, 9 and 13-16 under 35 U.S.C. § 103 on the basis of Tobin and Flagg is not sustained.

The examiner's rejection of claims 6, 7 and 17 under 35 U.S.C. § 103 on the basis of Tobin, Flagg and Beckham is not sustained.

The examiner's rejection of claims 8 and 10 under 35 U.S.C. § 103 on the basis of Tobin, Flagg and Berger is not sustained.

Pursuant to 37 CFR § 1.196(b), a new rejection of claims 1, 2, 4-10 and 16 under 35 U.S.C. § 112, first paragraph, has been entered by the Board.

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with

respect to the new grounds of rejection to avoid termination of proceedings

(37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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